



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,495	06/27/2001	Yusuke Monobe	50023-141	8799
20277	7590	01/24/2005	EXAMINER	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EDWARDS, PATRICK L	
			ART UNIT	PAPER NUMBER
			2621	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,495

Applicant(s)

MONOBE, YUSUKE

Examiner

Patrick L Edwards

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-12,14,16,18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-12,14,16,18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2621

DETAILED ACTION

1. The response received on August 25, 2004 has been placed in the file and was considered by the examiner. An action on the merits follows.

Response to Arguments

2. The applicant's arguments, filed on August 25, 2004, have been fully considered. A response to these arguments is provided below.

Claim and Specification Objections

Summary of Argument: In the previous office action, the disclosure and claims were objected to because of numerous grammatical errors. The applicant has amended the specification and claims to correct these issues and argues that these objections should be withdrawn.

Examiner's Response: The examiner greatly appreciates the applicants efforts to correct the aforementioned problems. The previous objections to the specification and claims are hereby withdrawn.

35 USC § 112, Second Paragraph Rejections

Summary of Argument: In the previous office action, claims 3, 14, 18-20, and 23 were rejected under 35 USC § 112(2) as being indefinite for failing to particularly point and distinctly claim the invention. Applicant has amended the claims to correct the cited errors and argues that the rejections to these claims should be withdrawn.

Examiner's Response: The examiner greatly appreciates the applicant's efforts to obviate these issues. The previous rejections under 35 USC § 112(2) are hereby withdrawn. However, new claim rejections under 35 USC § 112(2) have arisen as a result of applicant's amendment. These rejections will be provided below.

35 USC § 101 Rejections

Summary of Argument: In the previous office action, claims 18 and 19 were rejected under 35 USC § 101 as being directed to non-statutory subject matter. The applicant has amended claim 18 to incorporate the examiner's suggestion and obviate the rejection under 35 USC § 101.

Examiner's Response: The examiner appreciates the applicants efforts to resolve this issue. The rejection under 35 USC § 101 is hereby withdrawn.

Prior Art Rejections

Summary of Argument: Applicant argues that the Schwab reference does not disclose, teach, or suggest using the "sharing attribute information" as recited in the claim. Applicant provides a detailed explanation as to the

Art Unit: 2621

differences between the password information disclosed in Schwab, and the 'sharing attribute information' recited in the claim (see remarks pgs. 21-22).

Applicant further argues that the Schwab reference fails to meet all of the limitations of the amended claim 4. This amended claim contains a limitation from cancelled claim 5. Applicant has correctly noted that the language of the original claim 5 has been revised (see remarks pg. 22). The examiner asserts that this language revision has changed the scope of the claim, and rendered the prior rejection moot.

Applicant has amended claims 6 and 7 and argues that Schwab fails to meet the limitations of the amended claims.

Applicant has amended claims 11 and 22, and argues that the Schwab reference fails to meet the limitations of the newly amended claims.

Examiner's Response: Applicant's arguments have been fully considered, but are not persuasive. The examiner acknowledges the validity of the applicant's arguments, and agrees that the password disclosed in Schwab does not operate in the exact same manner as the 'sharing attribute information' in the instant application. However, the applicant is reminded that the claims are given their broadest reasonable interpretation, and that limitations from the specification are not read into the claims (see MPEP 2111). The examiner's interpretation of the limitation in question is provided in the below 112 rejection. Given this interpretation, it does not appear that the points that the applicant raises in his argument are necessary for anticipation of the claim. By the same rationale, it appears as if the Schwab reference reads on the claimed limitations. The 'sharing attribute information' recited in the claim is merely information which indicates whether or not an image should be sent from the terminal to the server. As was stated in the previous office action, Schwab discloses that some images are sent to the server, while others are not (i.e. there is no communication with the central database) (col. 4 lines 9-17). Schwab further discloses information which enables communication with this central database (col. 6 lines 50-51). Thus, this information qualifies as the claimed 'sharing attribute information'.

The applicant's amendment to claim 4 have changed the scope of the claim, and rendered the previous rejection moot. The new claims will be addressed in the below rejection.

Applicant's amendment to claim 6 and 7 have added additional limitations which have changed the scope of the claim and rendered the previous rejection moot. A new rejection of these claims will be provided below.

With regard to amended claims 11 and 22, the applicant's arguments have been fully considered, but are not persuasive. Schwab discloses layout information showing the kind and position of unit information included in the image (see Schwab Figure 3). Thus, the Schwab reference still reads on the claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2621

4. Claims 1, 3, 8-12, 14, 16, 18, 20, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to independent claims 1, 12, 16, and 18, the phrase 'image data corresponding to said management information provided in advance in said management information' is confusing, unclear, and ambiguous on several different levels. Is the image data provided in advance in said management information?, or is the management information provided in advance in said management information? After that question is answered, further questions remain. How can image data be provided in advance in said management information? What does this mean? How does this work? Further, how could management information be provided in advance in said management information? Is this phrase merely redundant, or are there two different levels of management information? Additionally, how could image data be simultaneously corresponding to management information, and also provide in advance in said management information? What is meant by 'provided in advance'?

The above questions show how the claim language can be interpreted several different ways, and how each of these interpretations is equally unclear. Thus, the metes and bounds of the above claims are not clear.

For examination purposes, the examiner will assume that the 'sharing attribute information' is simply information that indicates whether or not image data should be sent from a terminal to the server. This interpretation appears to be in accord with the applicant's remarks (see remarks pg. 20).

Claims 3, 8-11, 14, 20, and 23 are rejected because they are dependent on indefinite claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-7, 11-20 and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwab (USPN 6,226,412 B1).

With regard to claim 1, which is representative of claims 16, Schwab discloses image management terminals (col. 1 lines 18-23). The client computers located at remote sites as disclosed in Schwab are analogous to

Art Unit: 2621

the image management terminals recited in the claim, and the “central server computer” in Schwab functions as the claimed image management server.

Schwab further discloses providing the terminals with switchover control means for sending image data and management information to the image management server (col. 2 lines 4-7). Schwab discloses uploading images and text to the central computer. This ‘text’ disclosed in Schwab is analogous to the management information recited in the claim. It follows that the ‘central computer’ disclosed in Schwab is analogous to the image management server recited in the claims. Schwab further discloses sending the image data and management information (text and image information files mentioned at col. 3 line 39) according to instructions from a user (the user corresponds to the “manager” mentioned at col. 4 line 9, who chooses whether to send the information to the central server). The claimed “switchover control means” are components 12-20 shown in Figure 1 of Schwab. They send the information according to user instructions.

Schwab further discloses that the server has switchover image registration means for registering the image data and management information (which is acquired from the terminals) with specific storage means (col. 5 lines 25-32). The process of using the database files to reference the image files disclosed in the Schwab reference is analogous to the claimed process of registering image data and management information.

With regard to claim 2, which is representative of claim 17, Schwab further discloses that the management information stored in the terminal has sharing attribute information which indicates whether or not image data should be sent to the server (col. 4 lines 9-17). Schwab teaches making a determination about whether to list an image on the central server (i.e. share it) or keep it within the local database (i.e. not share it). If the image in Schwab is not shared, then communication with the central database is cut off (col. 4 lines 15-16). Schwab further discloses that a communication connection (col. 6 lines 50-51) between the terminal and server is accessed with a password (col. 6 lines 39-41), which links “the files themselves with the password” via file header information. Consequently, we can conclude that this password information associated with individual images is analogous to the sharing attribute information recited in the claim.

Schwab further discloses sending (or not sending) the image data and management information to the server on the basis of the sharing attribute information (col. 4 lines 9-17).

With regard to claim 3, Schwab discloses that the image management terminal is provided with a means for judging whether the image data selected by the user is stored in the image management server or in the image management terminal, and means for forwarding or executing a control instruction on the basis of the above determination (col. 8 lines 3-7). Schwab discloses retrieving selected item information and associated images from either the local database or the central database. The process of judging whether the image data is stored in either the local or central databases (the terminal or server) is inherent in retrieving the image from either one of the sources. Additionally, a control instruction must be forwarded or executed when one of the images is retrieved from either the local database or the central database. Moreover, as stated at col. 5 lines 28-32 in Schwab, “the storage locations of the associated image files managed by the image file server are referenced by the database file

Art Unit: 2621

server...” Thus, the database file server 30 functions as the claimed “storage place judging means” and communications server 20 functions as the claimed “terminal data control means”.

With regard to claim 4, Schwab discloses that the image management terminals store image data and management information for the user operating said image management terminal alone to utilize (col. 4 lines 9-15). Schwab’s terminal data control means is the selection screen and mouse, disclosed at col. 9 lines 34-55.

Schwab further discloses that the image management server stores the image data and management information for a plurality of users to share (col. 2 lines 50-52).

Schwab further discloses that the image management terminal has control means for management of both the image data stored in the image management terminals and the image data stored in the image management server (col. 9 lines 19-33). Schwab discloses managing the image data stored in the image management terminals (ie in the “local database” recited in the Schwab reference at col. 9 line 21). Schwab also discloses managing the image data stored in the image management server (ie the “central database” recited in the Schwab reference at col. 9 line 25). Although the Schwab reference doesn’t explicitly state that these processes are being coordinated by a “control means”, it does teach that “operator uses the mouse to effect the display of the selection screens”, and the image data for both the terminal and the server is managed via the selection screen as discussed at col. 9 lines 19-55.

Schwab further discloses displaying a plurality of images simultaneously on a display screen (schwab col. 8 line 4). Schwab discloses displaying images retrieved from either the local item or central item databases (schwab col. 8 lines 5-6). Schwab goes on to disclose that the images have item identification numbers assigned to them, and that the item identification numbers for images stored on the central database computer is different from an item identification number assigned by the computer to an image stored in the local database (Schwab col. 9 lines 19-33). These different identification numbers are displayed on the display screen in the item identification number text box. Thus, Schwab teaches the displaying the images in a visually distinguishable manner to indicate whether the displayed image is from the local database or the central database.

With regard to claim 11, Schwab discloses layout information showing the kind and position of unit information included in the image (see Schwab Figure 3).

With regard to claims 12 and 14, all of the limitations of the claims were addressed in the above rejections to claims 1 and 3, respectively.

With regard to claim 18, a program which causes the computer to execute the steps of a method is essential if the image processing method disclosed in Schwab is to function. Therefore, a program is inherently taught by the Schwab reference.

Regarding claims 20 and 23, the limitations were discussed above (see the claim 3 arguments).

The claim 22 limitations were discussed above (see the claim 11 arguments).

Art Unit: 2621

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8-10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab as applied to claims 1 and 4 above, and further in view of Nakabayashi et al. (USPN 5,905,866). The arguments as to the relevance of Schwab as applied in the above paragraphs are incorporated herein. With regard to claim 8, Schwab fails to disclose the claimed renewal information preparation means and mail sending means.

However, Nakabayashi, discloses a means for preparing renewal information showing the details of a renewal when the image data or management information stored in the image management server is given an addition or renewed, and mail sending means for sending the renewal information to specific users by electronic mail (Nakabayashi col. 48 lines 38-44). The data-update monitor server disclosed in Nakabayashi is analogous to the renewal information preparation means recited in the claim. It follows that the "results of the update check" disclosed in Nakabayashi is analogous to the "renewal information" recited in the claim. The registration management unit disclosed in Nakabayashi is analogous to the mail sending means recited in the claim.

It would have been obvious to one reasonably skilled in the art at the time of the invention to modify Schwab's image management system to include a renewal information preparation means and a mail sending means as taught by Nakabayashi. Such a modification would have allowed for an image management system in which the user was kept informed about updates to the central server (Nakabayashi col. 48 lines 32-37).

With regard to claim 9, Nakabayashi further discloses that the mail sending means only sends emails to the users who belong to the same group as the user who revised the image data or management information (Nakabayashi col. 48 lines 51-59). The number of users who utilize the same data-update monitor server as disclosed in Nakabayashi is analogous to "users who belong to the same group" as recited in the claim.

With regard to claim 10, Nakabayashi further discloses that the renewal information preparation means further prepares a renewal information list of renewals made for a specific period of time (Nakabayashi col. 48 lines 10-13).

With regard to claim 21, the limitations of the claim were discussed above (see claim 8).

9. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab (USPN 6,266,412) as applied to claim 4 above, and further in view of Matsuo (USPN 6,023,269) and Chatani (USPN 6,792,292).

With regard to claim 6, which is representative of claim 7 (because a background color is also a 'pattern'), Schwab discloses distinguishably displaying the images so that it can be identified whether the image is stored in a local database or a central server, but fails to expressly disclose that each image is displayed on an individually

Art Unit: 2621

assigned background area, and said image management terminals assigns a first color to the background area when the image data corresponding to the image displayed is stored in said image management server and assigns a second color to the background area when the image data corresponding to the image displayed is stored in said image management terminals.

Matsuo, however, discloses that each image is displayed on an individually assigned background area (Matsuo Figure 1, elements 120, 121, and 122: This figure shows that the DBMS window 122 is assigned to the data stored in the management server, and that the display processing program window is assigned to the data in the local database.). It would have been obvious to one reasonably skilled in the art at the time of the invention to modify the Schwab reference by adding individually assigned background areas as taught by Matsuo. Such a modification would have allowed for a clearer distinction between the two types of image data being displayed. Matsuo fails to expressly disclose that these individually assigned background areas have different background colors. Chatani, however, discloses assigning different colors to background of different images displayed in individual background areas (Chatani figures 15 and 16 in conjunction with col. 14 lines 37-62). It would have been obvious to one reasonably skilled in the art at the time of the invention to modify Matsuo's individually assigned background areas by assigning them different background colors as taught by Chatani. Such a modification would have allowed for even easier distinction between the types of image data being displayed.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick L Edwards whose telephone number is (703) 305-6301. The examiner can normally be reached on 8:30am - 5:00pm M-F.

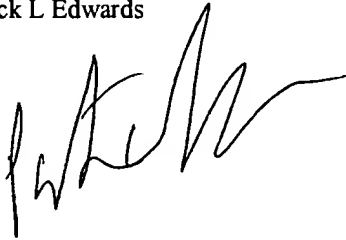
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau can be reached on (703) 305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2621

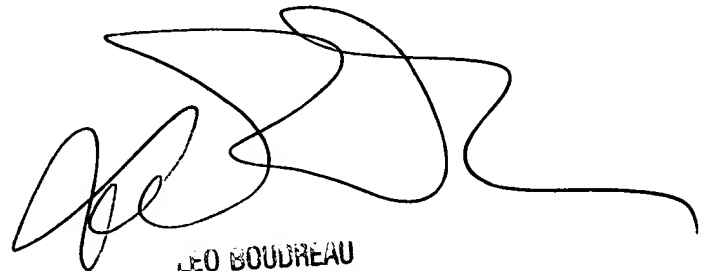
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick L Edwards

ple



Art Unit 2621



LEO BOUDREAU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600